

E-Filed: June 4, 2015

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

TESSERA, INC.,
Plaintiff,

v.

UTAC (TAIWAN) CORPORATION,
Defendant.

Case No. 10-cv-04435-EJD (HRL)

**ORDER RE: DISCOVERY DISPUTE
JOINT REPORT #13**

Re: Dkt. No. 290

Plaintiff Tessera, Inc. (“Tessera”) sues Defendant UTAC (Taiwan) Corporation (“UTC”) for alleged failure to pay royalties under a license agreement. The first phase of this action concerned a contract interpretation dispute between Tessera and UTC about the criteria for determining which UTC products are royalty-bearing. Following discovery on that subject, the parties submitted summary judgment motions relating to contract interpretation, which were ruled on by the court.

In the second phase of this action, Tessera served UTC with infringement disclosures identifying the products that Tessera contends are royalty-bearing under the agreement. Tessera’s July 8, 2014 disclosures identified 32 claims of 12 licensed patents and provided claim charts contending that two types of UTC packages—its w-BGA packages and DFN packages—are covered by the claims of licensed patents and are therefore royalty-bearing. Tessera’s disclosure asserted that Tessera did not have enough information to determine whether a third type of

1 package, UTC's LGA SiP package, is covered by the claims of the licensed patents and is
2 therefore royalty-bearing. UTC disputes Tessera's contentions, and also served Tessera with
3 invalidity contentions.

4 UTC has filed a motion for partial summary judgment, which is currently pending. Dkt.
5 Nos. 208, 247. Tessera opposed the motion, and the court has not yet issued a ruling. The parties
6 have also briefed and argued claim construction issues, and the court has not yet issued a claim
7 construction order.

8 Presently before the Court is the parties' Discovery Dispute Joint Report ("DDJR") #13.
9 Dkt. No. 290. The parties' dispute relates to RFP No. 85 in Tessera's 8th Set of Requests for
10 Production. Tessera requests that the Court order UTC to produce responsive documents to RFP
11 85, which seeks UTC's internal engineering communications related to the semiconductor
12 packages at issue. Tessera argues that these documents are relevant because they provide
13 evidence of UTC's alleged infringement of the asserted Tessera patents as well as evidence
14 rebutting invalidity contentions that have been raised by UTC. In addition, Tessera argues that
15 producing this discovery is not unduly burdensome. UTC argues that the requested discovery is
16 cumulative and unnecessary as well as overbroad and unduly burdensome.

17 Parties may obtain discovery about any nonprivileged matter that is relevant to any party's
18 claim or defense. Fed. R. Civ. P. 26(b)(1). "Relevance under Rule 26(b)(1) is construed more
19 broadly for discovery than for trial." *Truswal Sys. Corp. v. Hydro-Air Eng'g, Inc.*, 813 F.2d 1207,
20 1211 (Fed. Cir. 1987). "Relevant information need not be admissible at the trial if the discovery
21 appears reasonably calculated to lead to the discovery of admissible evidence." Fed. R. Civ. P.
22 26(b)(1).

23 Discovery is not unfettered, however. A court must limit the extent or frequency of
24 discovery if it finds that (a) the discovery sought is unreasonably cumulative or duplicative or can
25 be obtained from a source that is more convenient, less burdensome or less expensive; (b) the
26 party seeking discovery has had ample opportunity to obtain the information through discovery; or
27 (c) the burden or expense of the discovery sought outweighs its likely benefit, considering the
28 needs of the case, the amount in controversy, the parties' resources, the importance of the issues at
stake, and the importance of the discovery in resolving those issues. Fed. R. Civ. P.

1 26(b)(2)(C)(i)-(iii).

2 Here, RFP 85 seeks “All internal communications between UTC engineers, developers, or
3 researchers, relating to Packages at Issue.” “Packages at Issue” is defined as “all w-BGA
4 Packages and UTC Packages.” “UTC Packages” is defined as “any integrated circuit packages
5 made . . . or sold by UTC at any time other than w-BGA Packages, including but not limited to
6 DFN and LGA SiP Packages.” “W-BGA Packages” are defined as “packages made . . . or sold by
7 UTC on which UTC paid royalties to Tessera prior to September 24, 2010 or any substantially
8 similar packages.”

9 Tessera’s request is overbroad and unduly burdensome. Because UTC is in the business of
10 making integrated circuit packages, a large percentage of communications among UTC’s
11 engineers, developers, and researchers is likely to relate to such packages. UTC asserts that it
12 would take weeks to collect such communications, and it would require additional time and
13 expense for UTC’s counsel to sort through the documents to ensure that only responsive, non-
14 privileged documents are produced.

15 In addition, the requested discovery is cumulative and unnecessary. UTC has already
16 produced package drawings, wiring diagrams, bills of materials, specifications, data sheets and
17 training materials for the various assembly steps and processes involved in making the packages.
18 These engineering drawings and other technical documents show the structures, features, and
19 operations of the Packages at Issue. Tessera has no basis to contend that internal communications
20 would reveal anything relevant to the structure and operation of the packages that is not contained
21 in the engineering and technical documents that UTC has already produced.


22 In the alternative, Tessera states that it is willing to narrow its request to the following
23 UTC engineers that Tessera believes are likely to possess information most relevant to responding
24 to UTC’s non-infringement and invalidity defenses: Ken Keng (UTC’s head of research and
25 development); any predecessors to Ken Keng holding the title of head of research and
26 development or a substantially similar title; and Vincent Liu, Eric Kuo, and Norick Chang
27 (engineers in UTC’s Assembly Engineering Section). Tessera states that it is also willing to
28 narrow the date range of the request from 2001 (the year the parties entered the agreement) to the
present. This narrowed request, however, is also overbroad. It seeks the collection and production

1 of essentially all of the engineers' emails and other communications over a fourteen-year period.

2 Accordingly, Tessera's request that UTC be ordered to produce documents responsive to
3 RFP 85 is denied.

4 **IT IS SO ORDERED.**

5 Dated: June 4, 2015

6
7
8 
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28
HOWARD R. LLOYD
United States Magistrate Judge